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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/685,761	10/15/2003	Thomas W. Davison	1291.1121109	6309		
28075	7590	11/12/2008	EXAMINER			
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				NGUYEN, VI X		
ART UNIT		PAPER NUMBER				
3734						
MAIL DATE		DELIVERY MODE				
11/12/2008		PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/685,761	DAVISON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor X. Nguyen	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 June 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 71-76 and 79-83 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 71-76 and 79-83 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 71-76,79-81 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by Mollenauer et al (5,634,937). Mollenauer discloses in fig. 2 a surgical instrument is capable of allowing the insertion of different size instruments from the body cavity (see col.3, lines 58-66, col. 4, lines 1-16) including: element 10 is considered as a retractor or a cannula since it is capable for holding open the edges of the patient's body, where a proximal end of the retractor has an access opening, where the proximal end and the distal end has inner surfaces defining an access path (see fig. 8), where the retractor configures for an unexpanded configuration during insertion into the incision (fig. 2), and an expanded configuration when located in the patient surgical site (fig. 6b), and where an expander at 7 or 31 having a first portion pivotally connected to a second portion engages with the inner surface of the retractor ,and wherein pivoting the first and second portions away from each other to move the retractor from the unexpanded configuration to the expanded configuration (fig.6b). The examiner notes that the limitation “*wherein the retractor is structure to remain in the expanded configuration when the expander is withdrawn from the access path*” (an intended use limitation). The statement of intended use and other functional statements have been carefully considered but are deemed not to impose any structure limitations on the claims distinguishable over Mollenauer reference which is capable of

being used as claimed if one desires to do so. See MPEP 2106, MPEP 2111.04 and MPEP 2112.01. As to claims 72-75, it is noted that fig. 6b of Mollenauer clearly defined the distal end of element 10 in the expanded configuration has a first dimension greater than a second dimension, where the distal end has a cross sectional area greater than a cross sectional area at the access opening at the proximal end of the retractor, where the first portion of the retractor has an access path with a constant diameter and the second portion being configured for movement from the unexpanded to the expanded configuration, and where the distal end of the retractor completely surrounds an access path that provides access to the surgical site (a functional limitation): Thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. Accordingly, the reference is considered to read on the claimed limitation of the claimed noted. As to claims 76 and 83, it is noted that the retractor is formed a single piece of metal interconnected through a guide 10 and slot 14 within the guide, and the expander at 7 or 31 engages the distal end of the retractor and where the proximal and distal portions of the retractor are separate portions connected by a fastener at 21.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mollenauer et al (5,634,937) in view of Nwawka (6,036,638).

Mollenauer et al disclose the invention substantially as claimed. Mollenauer is silent regarding a guide moves along a slot.

Nwawka discloses a guide moves along a slot (fig. 1, element 62,64). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mollenauer by making the device has a guide moves along a slot as taught by Nwawka to lead to the pivot mechanism of the device to be adjusted in relation to the expansion of the retractor, because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable.

#### ***Response to Arguments***

3. Applicant's arguments filed 6/25/2008 have been fully considered but they are not persuasive. The newly amended claim language in the apparatus claims merely adds intended use and functional limitation. For-example, *wherein the retractor is structure to remain in the expanded configuration when the expander is withdrawn from the access path*". In fact, Mollenauer teaches that element 10 is considered as a retractor or a cannula(see col. 4, lines 1-4, and col. 5, lines 52-54), while an expander is element 7 or 31. Since the structure of Mollenauer meets all the structure elements of claims 71 and 80, Mollenauer anticipates the claims. There are no structure limitations of the Mollenauer device that would prevent it from being used in the spinal access system if one chooses to do so. It appears applicant is attempting to impart structure into his device by the use of functional language but applicant's device does not contain any more structure than the prior art device to meet the functional language.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN